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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,600	04/01/2002	Alain Autombard	IVD 1127	6447

27546      7590      06/11/2003  
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EXAMINER

ANDERSON, REBECCA L

ART UNIT      PAPER NUMBER

1626

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

10/030,600

## Applicant(s)

AULOMBARD ET AL.

## Examiner

Rebecca L. Anderson

## Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

Claims 1-34 are currently pending in the instant application.

#### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

**Group I**, claims 17, 18 and 31 drawn to the product of the formula (I).

**Group II**, claims 1 and 16 drawn to a process for the preparation of the compound of the formula (I).

**Group III**, claims 2 and 16 drawn to another process for the preparation of the compound of the formula (I).

**Group IV**, claims 3 and 16 drawn to another process for the preparation of the compound of the formula (I).

**Group V**, claims 4, 5 and 16 drawn to another process for the preparation of the compound of the formula (I).

**Group VI**, claims 6, 7, 16 and 32 drawn to another process for the preparation of the compound of the formula (I).

**Group VII**, claims 8, 9, 10 and 16 drawn to another process for the preparation of the compound of the formula (I).

**Group VIII**, claims 11, 12 and 16 drawn to another process for the preparation of the compound of the formula (I).

**Group IX**, claims 13, 15 and 16 drawn to another process for the preparation of the compound of the formula (I).

**Group X**, claims 14, 16, 33 and 34 drawn to another process for the preparation of the compound of the formula (I).

**Group XI**, claims 19 and 31 drawn to the product of the formula (II).

**Group XII**, claims 20 and 31 drawn to the product of the formula (IV).

**Group XIII**, claims 21, 22 and 31 drawn to the product of the formula (V).

**Group XIV**, claims 23, 24 and 31 drawn to the product of the formula (VI).

**Group XV**, claims 25 and 31 drawn to the product of the formula (VII).

**Group XVI**, claims 26, 28 and 31 drawn to the product of the formula (XIII).

**Group XVII**, claims 27, 28 and 31 drawn to the product of the formula (XIV).

**Group XVIII**, claims 29 and 31 drawn to the product of the formula (XIX).

**Group XIX**, claims 30 and 31 drawn to the product of the formula (XX).

The inventions listed as Groups I-XIV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Under 37 CFR 1.475(a), claims 1-34 contain 10 different technical features. The technical feature of claims 1-18 and 32-34 is the compound of the formula (I). The technical feature of claims 19 is the compound of formula (II). The technical feature of claim 20 is the compound of formula (IV). The technical feature of claims 21-22 is the compound of formula (V). The technical feature of claims 23 and 34 is the compound of formula (VI). The technical feature of claim 25 is the compound of formula (VII). The technical feature of claim 26 is the compound of formula (XIII). The technical feature of claim 27 is the compound of formula (XIV). The technical feature of claim 29 is the compound of formula (XIX). The

technical feature of the compound of claim 30 is the compound of formula (XX). Therefore, groups (I-IX), X, XI, XII, XIII, XIV, XV, XVI, XVII, XVIII do not contain the same technical feature and therefore lack unity of invention. For the groups I-X, under 37 CFR 1.475(a) the products and processes defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds and processes claimed contain the compound of the formula (I), which does not define a contribution over the prior art (as can be seen by WO 96/23787 and Tetrahedron: Asymmetry, 1998, 9, 3251-3262). The reactants, reagents, and reaction conditions vary extensively and when taken as a whole result in vastly different processes. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications in understanding the claimed subject matter imposes a serious burden on any examination of the claimed subject matter.

Therefore, since the claims do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical feature, the claims lack unity of invention and should be limited to only a product and a process for the manufacture of the said product.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

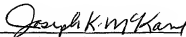
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



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